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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,735	12/28/2004	Yoshito Saji	10407-121US(A3048MT-US1)	2734

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AKIN GUMP STRAUSS HAUER & FELD L.L.P.  
ONE COMMERCE SQUARE  
2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103

EXAMINER
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KAYRISH, MATTHEW

ART UNIT	PAPER NUMBER
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2627

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/06/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/519,735	Applicant(s) SAJI ET AL.	
	Examiner Matthew G. Kayrish	Art Unit 2627	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-10,27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-10,27 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 5) <input type="checkbox"/> Notice of Informal Patent Application                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments filed 2/15/2007 have been fully considered but they are not persuasive.

In response to applicant's argument to claim 1 that Spector has portion [14A] that cooperates with the outer panel [18], the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Furthermore, in response to applicant's argument that Spector has portion [14A] that cooperates with the outer panel [18], and that Inoue and Aoki et al don't have a first or second functional portion, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Regarding the argument to claim 1, that Spector has portion [14A] that cooperates with the outer panel [18], and that Inoue and Aoki et al don't have a first or second functional portion, the primary reference discloses a disc cartridge which is needed in order to protect the disc while it is within the disc drive. By combining the cartridge of Aoki and Inoue with the design of Spector, the cartridge and disc will display

the audiovisual effects of the contents on the disc. However, since there is no reason for the disc to be removed from the cartridge in this case, i.e. the disc and the cartridge need to work in conjunction with each other when inserted into the housing, as clearly displayed in figures 19 & 21 of Inoue and in figure 21 of Aoki. Therefore, there is no reason to separate the disc from the cartridge, and therefore, no reason to design the base of the inside of the cartridge. Therefore, Aoki and Inoue disclose "wherein the cartridge body is not provided with a portion that produces the audiovisual effect by cooperating with the first functional portion of the disc," as clearly seen in figure 29 of Aoki and figure 1 of Inoue, as newly claimed in amended claim 1.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5-7, 10, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki et al (US Patent Number 6407982), in view of Inoue (US Patent Number 6590858), in further view of Spector (US Patent Number 5600628).

Regarding claim 1, Aoki et al discloses:

A disc cartridge for storing a disc that has a first side with a first functional portion and a second side, the disc cartridge comprising:

A cartridge body including a disc storage portion (figure 5, item 2b), a chucking opening (figure 2, item 3a) and a head opening (figure 2, item 3b), wherein the disc storage portion has a disc window (figure 2, item 2) and a bottom (figure 2, item 4) and stores the disc therein so that the first side thereof is exposed through the disc window (figure 7, disc [D] will be exposed when in recess);

The chucking opening is provided on the bottom of the disc storage portion (figures 23 and 24, disk gets chucked by item 55) so as to get the disc chucked externally (column 20, lines 20-25); and

The head opening is also provided on the bottom of the disc storage portion so as to allow a head (figure 24, item 61), which reads and/or writes data from/on the second side of the disc, to access the second side of the disc (column 20, lines 43-48);

Wherein the cartridge body is not provided with a portion that produces the audiovisual effect by cooperating with the first functional portion of the disc (figure 29, item 112).

Aoki et al fails to disclose:

A shutter, which is supported to, and movable with respect to, the cartridge body so as to expose or cover at least the head opening; and

A second functional portion, which is provided for the cartridge body and which produces an audiovisual effect by cooperating with the first functional portion of the disc.

Inoue discloses:

A shutter (figure 1, item 18), which is supported to (figure 1, via items 27a & 27b), and movable with respect to, the cartridge body (figure 1, items 13 and 15) so as to expose or cover at least the head opening (figure 3, head opening is exposed); and

Inoue fails to specifically disclose:

A second functional portion, which is provided for the cartridge body and which produces an audiovisual effect by cooperating with the first functional portion of the disc.

Spector discloses:

A second functional portion, which is provided for the cartridge body and which produces an audiovisual effect by cooperating with the first functional portion of the disc (figure 6, item 18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Aoki et al's cartridge with a shutter, as taught by Inoue, because shutters protect the face of the disk, as mentioned in column 2, lines 7-9. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Aoki et al with a design style utilizing the image on the disc and the completed image on the panel, as taught by Spector, because this will provide the user with a visual image of the audio content on the disc, and will furthermore help the user identify the contents of the disk before placing the disk into the player as mentioned by Spector in columns 2 and 4, lines 46-48 and 35-41.

Regarding claim 2, Aoki et al and Inoue disclose the features of base claim 1 as stated in the 103 rejection above, but fail to disclose:

Wherein the first and second functional portions produce a visual effect by cooperating with each other.

Spector discloses:

Wherein the first and second functional portions which produce a visual effect by cooperating with each other (figure 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Aoki et al & Inoue's cartridge with the design style utilizing the image on the disc and the completed image on the panel, as taught by Spector, because this will provide the user with a visual image of the audio content on the disc, and will furthermore help the user identify the contents of the disk before placing the disk into the player as mentioned by Spector in columns 2 and 4, lines 46-48 and 35-41.

Regarding claim 5, Aoki et al, Inoue and Spector disclose the features of base claim 2 as stated in the 103 rejection above, and Spector further discloses:

Wherein the first functional portion which is a first design provided on the first side (figure 1, item 14), a second functional portion which is a second design provided on a portion of the upper surface of the cartridge body (figure 6, item 18), near the disc window (figure 6, item 19), and the first and second designs are combined together to make up a third design that looks like a single continuous design (column 4, lines 23-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that providing Aoki et al & Inoue's cartridge with the design

style utilizing the image on the disc and the completed image on the panel, as taught by Spector, because this will provide the user with a visual image of the audio content on the disc, and will furthermore help the user identify the contents of the disk before placing the disk into the player as mentioned by Spector in columns 2 and 4, lines 46-48 and 35-41. Furthermore, the combination would place this audiovisual effect near the disc window.

Regarding claim 6, Aoki et al, Inoue and Spector disclose the features of base claim 5 as stated in the 103 rejection above, and Spector further discloses:

Wherein the first design is a picture drawn on the first side (figure 1, item 14) and the second design is a picture drawn on the upper surface (figure 6, item 18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to create the audiovisual effect out of a picture, as taught by Spector, because the audiovisual effect helps create an image in the users head of the audio portion of the disc, and will furthermore help the user identify the contents of the disk before placing the disk into the player as mentioned by Spector in columns 2 and 4, lines 46-48 and 35-41.

Regarding claim 7, Aoki et al, Inoue and Spector disclose the features of base claim 6 as stated in the 103 rejection above, and Spector further discloses:

Wherein the first and second designs are planar (figure 4, item 10 is planar with item 18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to give Aoki et al & Inoue's the disc window a depth equal



to that of the disc, as taught by Spector, because this will prevent inconsistencies in the image created by the disc in combination with the cartridge.

Regarding claim 10, Aoki et al, Inoue and Spector disclose the features of base claim 6 as stated in the 103 rejection above, and Spector further discloses:

Wherein the first side of the disc and the upper surface of the cartridge body are textured (column 3, lines 44-47, paper is textured).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to create the audiovisual of a textured adhesive paper, as taught by Spector, because this would make it cheaper to recreate in the instances that mistakes are made when painting directly on or embossing onto the disc.

Regarding claims 27 and 28, Aoki et al, Inoue and Spector disclose the features of base claim 1 as stated in the 103 rejection above, and Inoue further disclosing:

A disc drive comprising:

A supporting portion into which the disc cartridge of claim 1 is loadable (figure 21, item 62);

A spindle motor for mounting and rotating the disc thereon (figure 18, item 68);

A head, which is able to read and/or write data from/on the second side of the disc (figure 18, item 69);

A sensor for detecting a rotational angular position of the spindle motor when the disc is mounted on the spindle motor (figure 18, item D7); and

A control section for controlling the spindle motor in accordance with a command to eject the disc cartridge such that the spindle motor stops at the rotational angular

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position when the disc is mounted thereon (figure 18, item D1 must be connected to an ejection button).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the cartridge of Aoki et al and Spector in a disc drive with each of these components, as taught by Inoue, because disc drives are well-known to have each of these components.

Claims 8 and 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki et al, Inoue and Spector as applied to claim 6 above, and further in view of Everidge et al (US Patent Number 6400675).

Regarding claim 8, Aoki et al, Inoue and Spector disclose the features of base claim 6 as stated in the 103 rejection above, but fail to specifically disclose:

Wherein the first and second designs are embossed.

Everidge discloses:

An embossed design on the disk (column 3, lines 41-48).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to emboss the first and second designs disclosed in Aoki's, Inoue's and Spector's device, as taught by Everidge, because this will prevent deterioration of the image on the disc cartridge, since the image is physically part of the disc and cartridge, rather than simply painted thereon.

Regarding claim 9, Aoki et al, Inoue, Spector and Everidge disclose the features of base claim 8, as stated in the 103 rejection above, and Spector further disclosing:

Wherein the depth of the first design is substantially equal to that of the second design (figure 4, designs of disc [10] are at the same depth as that of the outer panel [18]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide for the images on the cartridge of Aoki et al, Inoue and Everidge to be embossed to an equal depth, as taught by Spector, because this will provide for an even, consistent image which will not show any discontinuities, as shown in figure 3.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew G. Kayrish whose telephone number is 571-272-4220. The examiner can normally be reached on 8am - 5pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on 571-272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew G. Kayrish

3/21/2007

MK

  
3/21/2007  
WAYNE YOUNG  
SUPERVISORY PATENT EXAMINER